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HARRINGTON & SMITH, LLP
4 RESEARCH DRIVE
SHELTON, CT 06484-6212

EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/559,499

Applicant(s)

PIIKIVI ET AL.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-16 and 18-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9-16 and 18-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Amendment C, paper # 11, received on 05/06/2003 is acknowledged and entered. Claims 2, 8, 17, and 32 are canceled. Claims 1, 7, 16 and 31 are amended. Currently claims 1, 3-7, 9-16, and 18-32 are pending for examination.

Response to Arguments

2. Applicant's arguments filed on 05/06/2003 with regards to canceled claims 2, 8, 17, amended claims 1, 7, 16, and claims 9 and 22 have been fully considered but they are not persuasive for following reasons:

2.1. In response to applicant's argument that "The Applicant still believes that the claim amendments made in the Response dated 9/6/2003 patently distinguish over Wang" (see Response dated 05/06/2003 page 6), the examiner does not agree as the applicant has not provided any reasoning as how the amendments made in the Response date 9/6/2002 patently distinguish over the rejection of claims 1, 3-7, 10-16, and 18-20 presented in the earlier Office Action, paper # 10, mailed on 03/06/2003.

2.2. In response to applicant's argument that " Wang cannot be modified such that a user PIN number is entered at a mobile station without violating explicit teachings of the reference ", " There appears no motivation within the references to combine the

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two.....Applicant hereby requests the Examiner reconsider his combination of Wang and Ladd for personal authentication purposes in light of the above “, “ Applicant requests the Examiner reconsider his combination of Wang with Ladd and withdraw his rejections based thereon that would otherwise be imputed to claims 1, 7, 9 and 16, as amended herein “, and “ As detailed above in the discussion of the combination of Wang with Ladd, Wang teaches away from prompting a user to enter personal authentication information using one of a computer user interface...in claim 22 “ (see Response dated 05/06/2003, pages 7 and 8), , the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case the test for obviousness is not whether the features of Ladd, that is using PIN as an identification tool may be bodily incorporated into the structure of the Wang; nor is it that the claimed invention must be expressly suggested in Wang or Ladd. Rather, the test is that the combined teachings of Wang/Ladd would have suggested the limitations of claims 1, 7, 9 and 16, as analyzed and demonstrated in the earlier Office Action on pages 5-7, and 9 to those of ordinary skill in the art.

Also in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

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where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Wang/Ladd combined teaches the claimed limitations of the amended claims 1, 7, 9, and 16 as analyzed and demonstrated in the earlier Office Action on pages 5-7, and 9.

The applicant is also requested to refer to the following court cases which justify the combination of Wang and Ladd as analyzed and demonstrated in the earlier Office Action on pages 5-7, and 9.

In re Sheckler, 168 USPQ 716 (CCPA 1971)

It is not necessary that a reference actually suggest changes or possible improvements which applicant made.

In re Fine, 5 USPQ2d 1596 (CA FC 1988)

The PTO can satisfy the burden under section 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

In re Bozek, 163 USPQ 545 (CCPA 1969)

"Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness 'from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.'"

In re Gershon, Goldberg, and Neiditch, 152 USPQ 602 (CCPA 1967)

"Although references do not disclose or suggest the existence of applicants' problem or its cause, claims are rejected under 35 U.S.C. 103 since references suggest a solution to problem; it is sufficient that references suggest doing what applicants did, although they do not teach or suggest exactly why this should be done, other than to obtain the expected superior beneficial results."

In re Beattie, 24 USPQ2d 1040 (CA FC 1992)

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"Board of Patent Appeals and Interferences correctly held that it would be obvious to one having ordinary skill in art to combine prior art references in order to arrive at claimed marking system for reading and playing music on keyboard or stringed instruments, despite absence of single express teaching of marking system which combines two musical theories of prior art references, since law of obviousness does not require that references be combined for reasons contemplated by inventor, but only looks to whether some motivation or suggestion to combine references is provided by prior art taken as whole. "

2.2. With regards to the Applicant's arguments, " Additionally, claim22 For security purposes, a proprietary channel is preferable to publicly kown method such as MIME, so Wang;s lack of disclosuresuch as MIME " (see Response page 8), the examiner respectfully disagrees for following reasons:

In response to applicant's argument, that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., " Claim 22 does not require downloading code from a server ...and site to satisfy claim 22, not code as require by Wang ") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Also in response to applicant's argument that " Claim 22 does not require downloading code from a server ...and site to satisfy claim 22, not code as require by Wang " (see Response page 8), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result

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in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

2.3. In response to applicant's arguments, regarding claims 23, 30, and 31, "Applicant is unaware of any teaching within Wang that contemplates a list of certificates that are applicable to the transaction requestreconsider and withdraw the novelty rejection of claims 23-31 as amended herein " (see Response page 9), the examiner respectfully disagrees. Wang, see col.15, line 40-col.16, line 67, teaches that during a transaction for purchase of appliances or purchase/sale of securities Wang contemplates using a list of certificates/data/information such as user's signature, user's facial image, finger print, voice print....as unique identifying data to eliminate fraud (see col.16, lines 20-34) and accessible by a mobile terminal that is PEAD in Wang..

2.4. In response to the applicant's arguments regarding rejection of claims 1-6, 21, and 31-32 under USC 112, first paragraph they are persuasive and as such this rejection is withdrawn.

In view of the foregoing the Prior art rejection of claims 1, 3-7, 9-16, 18-31 is being maintained.

This is a final rejection.

3. **Note:** The prior art rejection of claims 1, 3-7, 9-16, 18-31 is to be viewed in the light of "Response to Arguments" presented above.

Claim Rejections - 35 USC § 102

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e)

Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.

4.1. Claims 23-25, and 28-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang.

With regards to claims 23-25, and 28-31, Wang discloses a method and a system for approving transactions that involves sending a transaction authorization request over a bi-directional link between a vendor server and a portable electronic authorization device such as a cellular phone. A user with an Internet-enabled mobile device such as a cellular phone can contact a merchant's Internet server through a wireless gateway implemented using a short range wireless communication capability such as Bluetooth, and the merchant server can transmit encrypted messages to the user's cellular phone in response via a Requesting Device 202 (FIG.2, which is a computer terminal, see at least col.4, lines 56-61) or 904 (see FIG.9A, col.15, lines 19-40). The user's mobile station can have pre-installed software for performing electronic transaction verification, or the merchant server can download a transaction program TP to the Requesting Device (see col.15, lines 41-col.20, line 43) to enable the electronic transaction. The user can generate and send to the remote server user identification and authentication data, such as the user's digital signature, and authorization of the

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transaction. In response, the merchant site can download authorization confirmation and any electronic tokens required for accessing the service, such as an electronic ticket, to the user's mobile device for future service authorization (see at least Fig. 3A, Fig. 5B, Fig. 7A, Fig. 9A, col. 14 line 63 - col. 15 line 47, col. 16, lines 7 - col. 17 line 19, col. 18, line 33 - col. 19 line 52).

Wang further discloses automatically detecting the presence of a mobile device for user authentication. Wang shows that the transaction program TP downloaded on the requesting device- a computer terminal-between the commerce site server and the mobile station i.e. PEAD-includes an executable program and detects the presence of approval device, if that approval device is embedded or external and further communicates with PEAD-the mobile station-to obtain approval/authentication data (see col.15, line 40-col.16, line 67). Therefore, it is implied that the requesting device, a computer terminal between the commerce site and the mobile station with the help of the Transaction program TP automatically detects the message from the server requesting authentication of the user or requiring other data like user's signature certificate, etc. and communicates with the mobile station -PEAD. This is in line with the rationale used in the application to detect the message from the server and redirect it to the mobile station (see page 4, lines 14-20 and page 5, lines 4-9, where a software module or plug-in the computer PC1 recognizes the message from the server and redirects it to mobile station.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.1. Claims 1, 3-7, 9-16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Ladd et al. (US 6,269,336), hereinafter referred to as Ladd.

With regards to claims 1, 3-7, 9-16, and 18-20, Wang discloses a method and a system for approving transactions that involves sending a transaction authorization request over a bi-directional link between a vendor server and a portable electronic authorization device such as a cellular phone. A user with an Internet-enabled mobile device such as a cellular phone can contact a merchant's Internet server through a wireless gateway implemented using a short range wireless communication capability such as Bluetooth, and the merchant server can transmit encrypted messages to the user's cellular phone in response via a Requesting Device 202 (FIG.2, which is a computer terminal, see at least col.4, lines 56-61) or 904 (see FIG.9A, col.15, lines 19-40). The user's mobile station can have pre-installed software for performing electronic transaction verification, or the merchant server can download a transaction program TP to the Requesting Device (see col.15, lines 41-col.20, line 43) to enable the electronic

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transaction. The user can generate and send to the remote server user identification and authentication data, such as the user's digital signature, and authorization of the transaction. In response, the merchant site can download authorization confirmation and any electronic tokens required for accessing the service, such as an electronic ticket, to the user's mobile device for future service authorization (see at least Fig. 3A, Fig. 5B, Fig. 7A, Fig. 9A, col. 14 line 63 - col. 15 line 47, col. 16, lines 7 - col. 17 line 19, col. 18, line 33 - col. 19 line 52).

Wang further discloses automatically detecting the presence of a mobile device for user authentication. Wang shows that the transaction program TP downloaded on the requesting device- a computer terminal-between the commerce site server and the mobile station i.e. PEAD-includes an executable program and detects the presence of approval device, if that approval device is embedded or external and further communicates with PEAD-the mobile station-to obtain approval/authentication data (see col.15, line 40-col.16, line 67). Therefore, it is implied that the requesting device, a computer terminal between the commerce site and the mobile station with the help of the Transaction program TP automatically detects the message from the server requesting authentication of the user or requiring other data like user's signature certificate, etc. and communicates with the mobile station -PEAD. This is in line with the rationale used in the application to detect the message from the server and redirect it to the mobile station (see page 4, lines 14-20 and page 5, lines 4-9, where a software module or plug-in the computer PC1 recognizes the message from the server and redirects it to mobile station.

Wang, as discussed above, substantially provides the claimed invention, including entering PIN numbers via a keypad by a user of an ATM for authentication by comparing the PIN with a PIN stored at a remote computer, but fails to provide a user entering a PIN into a mobile station. Ladd teaches a mobile station such as a mobile phone, PDA or pager, that prompts a user to enter a unique PIN for user identification. It would have been obvious to one having ordinary skill in the art at the time of the invention to combine Wang's electronic transaction system with the teaching of Ladd regarding prompting a user to enter a PIN at a mobile station. Doing so would provide a simple means to identify a user and prevent unauthorized use of a mobile station, thus increasing user security.

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang/Ladd in view of Donoho. et al. (US Patent 6,256,664), hereinafter referred to as Donoho.

6.1. With regards to claims 21, Wang/Ladd teaches a method for conducting communication with a commerce related site on Internet as disclosed and analyzed in claims 1 and 23 above. Wang/Ladd does not disclose parsing messages using MIME standard. However, parsing messages using MIME is an old and well-known practice in the field of computer related messaging on Internet as explicitly disclosed in Donoho (see at least, col.14, lines 29-49, col.22, line 1-col.31, line 14). Donoho expressly teaches the use of MIME standard and parsing messages to transport files over the Internet. It would have been obvious to a person of an ordinary

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skill in the art at the time of the invention to modify Wang/Ladd to include the feature of parsing messages and using MIME standard to transport messages/electronic mails/packages over the Internet as explicitly disclosed in Donoho.

7. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Donoho. et al. (US Patent 6,256,664), hereinafter referred to as Donoho.

7.1. With regards to claims 26-27, Wang teaches a method for conducting communication with a commerce related site on Internet as disclosed and analyzed in claims 1 and 23 above. Wang does not disclose parsing messages using MIME standard. However, parsing messages using MIME is an old and well-known practice in the field of computer related messaging on Internet as explicitly disclosed in Donoho (see at least, col.14, lines 29-49, col.22, line 1-col.31, line 14). Donoho expressly teaches the use of MIME standard and parsing messages to transport files over the Internet. It would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Wang to include the feature of parsing messages and using MIME standard to transport messages/electronic mails/packages over the Internet as explicitly disclosed in Donoho.

8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang/Ladd in view of Donoho. et al. (US Patent 6,256,664), hereinafter referred to as Donoho.

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8.1. With regards to claim 22, all limitations correspond to the limitations of claims 21 and 27, as analyzed and rejected above and therefore the same rationale is used to reject claim 22.

Conclusion

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed; and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

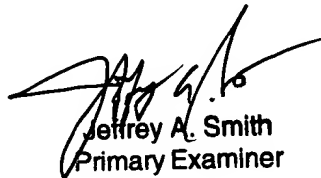
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305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg
Examiner
Art Unit 3625

YCG
July 8, 2003



Jeffrey A. Smith
Primary Examiner